

BS00097 CIP 1
U.S. Application No. 10/802,085 Examiner Chow, Art Unit 2645
Request for Reconsideration in Response to January 25, 2006 Office Action

REMARKS

In response to the Office Action dated January 25, 2006, the Assignee respectfully requests reconsideration based on the following remarks. The Assignee respectfully submits that the pending claims already distinguish over the cited patents to *Wilk* and *Ericson*.

Claims 1-5, 8-12, and 15-22 are pending in this application.

The United States Patent and Trademark Office (the "Office") rejected claims 1-5, 8-12, 15-17, and 21-22 under 35 U.S.C. § 103 (a) as being unpatentable over U.S. Patent 6,768,789 to *Wilk*. Claims 18-20 were rejected under 35 U.S.C. § 103 (a) as being unpatentable over *Wilk* in view of U.S. Patent 6,666,376 to *Ericson*.

The pending claims, however, already recite features not taught or suggested by *Wilk* and/or *Ericson*. The Assignee, then, respectively submits that the pending claims already distinguish over the cited patents to *Wilk* and *Ericson*.

Telephone Interview with Examiner Gauthier

Examiner Gauthier discussed this response. A telephone interview was held March 23rd with Examiner Gauthier. Examiner Gauthier explained that the previous examiner is no longer with the Patent Office, so Examiner Gauthier has taken over this case. Examiner Gauthier then said that he agreed with the arguments presented herein. He will perform another search and issue another office action.

Rejection of Claims Under 35 U.S.C. § 103

The Office rejects claims 1-5, 8-12, 15-17, and 21-22 under 35 U.S.C. § 103 (a) as being unpatentable over U.S. Patent 6,768,789 to *Wilk*. Claims 18-20 were rejected under 35 U.S.C. § 103 (a) as being unpatentable over *Wilk* in view of U.S. Patent 6,666,376 to *Ericson*. If the

BS00097 CIP 1
U.S. Application No. 10/802,085 Examiner Chow, Art Unit 2645
Request for Reconsideration in Response to January 25, 2006 Office Action

Office wishes to establish a *prima facie* case of obviousness, three criteria must be met: 1) combining prior art requires "some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill"; 2) there must be a reasonable expectation of success; and 3) all the claimed limitations must be taught or suggested by the prior art. DEPARTMENT OF COMMERCE, MANUAL OF PATENT EXAMINING PROCEDURE, § 2143 (orig. 8th Edition) (hereinafter "M.P.E.P.").

The pending claims are not obvious. All the pending claims recite, or incorporate, features not taught or suggested by *Wilk* and/or *Ericson*. Independent claim 1, for example, recites "accessing a database of pre-created text messages, the database storing a pre-created text message having a common association between the receiving party and the originating party" (emphasis added). Independent claim 1 also recites "communicating the pre-created text message to an Internet Protocol address associated with the originating party" Independent claim 1 is reproduced below, and independent claims 9, 21, and 22 recite similar features.

[c01] (Previously Presented) A method of providing communications services, comprising the steps of:

receiving caller identification information identifying a call from an originating party to a receiving party;

accessing a database of pre-created text messages, the database storing a pre-created text message having a common association between the receiving party and the originating party; and

communicating the pre-created text message to an Internet Protocol address associated with the originating party.

Wilk and/or *Ericson* do not obviate such features. The previous Examiner Chow is correct — *Wilk* and/or *Ericson* teach a "storage device for storing a plurality of predefined outgoing messages." U.S. Patent 6,768,789 to *Wilk* (Jul. 27, 2004) at column 2, lines 21-22. As the Assignee has previously argued, however, *Wilk* stores **prerecorded outgoing voice messages for the calling party**. As *Wilk* explains, the callee "prerecords" one or more voice messages. See U.S. Patent 6,768,789 to *Wilk* (Jul. 27, 2004) at column 4, lines 18-25 (emphasis

BS00097 CIP 1
U.S. Application No. 10/802,085 Examiner Chow, Art Unit 2645
Request for Reconsideration in Response to January 25, 2006 Office Action

added). When a call is received, the callee makes a selection and the selected message is then "played to the caller." *Id.* at column 5, lines 57-62 (emphasis added). *Wilk* does not "[access] a database of pre-created text messages" and "communicat[e] the pre-created text message to an Internet Protocol address associated with the originating party," as the independent claims recite.

Wilk also mentions SMS text messages. These text messages, however, are sent to the called party. *Wilk* does not teach or suggest "accessing a database of pre-created text messages, the database storing a pre-created text message having a common association between the receiving party and the originating party" (emphasis added). Independent claim 1 also recites "communicating the pre-created text message to an Internet Protocol address associated with the originating party" As *Wilk* explains, "the caller at caller telephone 48 can be provided with the option to leave a message in a voicemail box designated by the callee, or offered the opportunity to provide a text message (for example, using the SMS protocol) that will appear on the display of a wireless telephone." *Id.* at column 5, line 66 through column 6, line 4. Because *Wilk* and/or *Ericson* fails to teach or suggest "accessing a database of pre-created text messages" and "communicating the pre-created text message to an Internet Protocol address associated with the originating party," one of ordinary skill in the art would not think that the claims are obvious.

Wilk also mentions text-to-speech messages. *Wilk* explains that the callee may prepare a text message for the calling party. *See id.* at column 7, lines 48-50. The text message, however, is then converted to speech "using a text-to-speech generator." *Id.* at column 7, lines 49-51. So, *Wilk* still communicates a voice message to the calling party. *Wilk* does not "communicat[e] the pre-created text message to an Internet Protocol address associated with the originating party."

Wilk and/or *Ericson*, then, cannot obviate the pending claims. Claims 1-5, 8-12, and 15-22 recite, or incorporate, features not taught or suggested by *Wilk* and/or *Ericson*. Because *Wilk* and/or *Ericson* are each silent to "accessing a database of pre-created text messages" and to "communicating the pre-created text message to an Internet Protocol address associated with

BS00097 CIP 1
U.S. Application No. 10/802,085 Examiner Chow, Art Unit 2645
Request for Reconsideration in Response to January 25, 2006 Office Action

the originating party," one of ordinary skill in the art would not think that the claims are obvious.
Examiner Gauthier is respectfully requested to remove the § 103 (a) rejections of the claims.

If any issues remain outstanding, the Office is requested to contact the undersigned at
(919) 387-6907 or scott@wzpatents.com.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Scott P. Zimmerman", with a stylized flourish at the end.

Scott P. Zimmerman
Attorney for the Assignee
Reg. No. 41,390